

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on April 19, 2006, the Examiner rejected claims 1, 4, 8-9, 12-15, and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,181,107 to Rhoades (hereinafter “Rhoades”). In addition, the Examiner rejected claims 2, 10, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of U.S. Patent Application Publication No. 2001/0007105 to Brotz et al. (hereinafter “Brotz”), rejected claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of U.S. Patent Application Publication No. 2002/0144265 to Connelly (hereinafter “Connelley”), rejected claim 5 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of U.S. Patent No. 6,401,059 to Shen et al. (hereinafter “Shen”), and rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Connelly and further in view of “The Set-Top Box as ‘Multi-Media Terminals’” by Pekowsky and Jaeger (hereinafter “Pekowsky”). Accordingly, Applicant respectfully provides the following:

Rejections under 35 U.S.C. 102

In the Office Action, the Examiner rejected claims 1, 4, 8-9, 12-15, and 19 under 35 U.S.C. 102(b) as being anticipated by Rhoades. Applicant respectfully submits that the claim set as provided herein is not anticipated by the cited reference.

The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides:

[F]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.

Applicant respectfully submits that the cited reference does not explicitly or impliedly teach every aspect of the amended claim set as provided herein and therefore does not anticipate the claims of the present invention.

In particular, independent claim 1 recites a local service “provided by a local service provider without notification to the remote service provider” wherein the local service “bypasses a distribution system used for said remote programming broadcast.” This highlights a major difference between the present system and the system taught by Rhoades. Rhoades teaches a system commonly used by cable systems where the cable system is the source of all downloaded and viewed information and broadcasts, regardless of whether the information and broadcast has been previously downloaded and then re-accessed locally or is being originally downloaded or broadcast for the first time. The present invention is different and advantageous in that it provides for local services that are independent from the broadcast provider such as the cable system. The disadvantages of the old systems taught by Rhoades are taught by the specification as filed on Page 3 lines 13-22, while the advantages of the present invention as claimed are taught throughout the specification. (See, for example, Page 8 lines 8-17 and Page 9 lines 8-11)

Independent claims 9 and 15 (and new independent claim 29) recite similar limitations that clarify that the local service is provided by a source independent from the primary programming broadcast. This limitation included in all the claims therefore provides that the broadcast is enhanced locally with a local service. In contrast, Applicant respectfully submits that Rhoades does not explicitly or impliedly teach such limitations. Accordingly, for at least these reasons, Applicant submits that Rhoades does not anticipate the independent claims of the present invention. And, since the dependent claims provide additional limitations to the

corresponding independent claims, Applicant respectfully submits that Rhoades similarly does not anticipate the dependent claims of the present invention.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 2, 10, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Brotz, rejected claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Connelley, rejected claim 5 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Shen, and rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Connelly and further in view of Pekowsky. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention.

As discussed above, independent claim 1 recites a local service “provided by a local service provider without notification to the remote service provider” wherein the local service “bypasses a distribution system used for said remote programming broadcast.” These limitations are supported by the application as originally filed. All other independent claims include similar limitations.

However, in contrast, none of the references cited by the Examiner, alone or in combination, teach or suggest such limitations. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the independent claims as provided herein. In addition, dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that for at least these reasons the cited references do not teach or suggest, alone or in combination, the limitations claimed in the present claim set and therefore do not make obvious the claim set provided herein.

Additionally, Applicant respectfully reiterates the submission that the cited references do not make obvious the claim set provided herein since the cited references teach away from the present invention as claimed. For example, Rhodes teaches of “a home computing assembly capable of establishing a digital, interactive communications system providing a plurality of subscribers access to a variety of information services stored in a plurality of remote information services storage centers.” [emphasis added] (see col. 1, lines 12-15). Furthermore, Rhodes teaches that “any of a plurality of individual subscribers may request one of a plurality of information services stored in a software program library at a remote location utilizing a home computing element or assembly to establish a bi-directional telephone communication link with a remote information services storage center to access the services offered.” [emphasis added] (see col. 2, lines 45-51). Accordingly, Applicant respectfully submits that Rhodes at least teaches away from a local third-party service as claimed in the present invention, and thus the cited references do not make obvious the present invention as claimed herein.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 13 day of July, 2006.

Respectfully submitted,



Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

ADS

::ODMA\PCDOCS\DOCS\904087\1